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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,871	03/16/2004	Sung-hee Hwang	1793.1218	1566

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STEIN MCEWEN, LLP
1400 EYE STREET, NW
SUITE 300
WASHINGTON, DC 20005

EXAMINER	
ORTIZ CRIADO, JORGE L	
ART UNIT	PAPER NUMBER
2627	
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05/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/800,871	HWANG ET AL.	
	Examiner	Art Unit	
	JORGE L. ORTIZ CRIADO	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *22-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-7, 13-14 and 20-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recites "contiguously recording the temporary defect information", and the examiner cannot ascertain where in the specification support for this limitation is found. Hence the limitation is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language a multiple N=1, 2, "…" And renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "…"), thereby rendering the scope of the claim(s) unascertainable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by park et al. U.S. Pat. No. 7,289,404.

Regarding claim 1, Park et al. discloses a recording method, comprising:

recording temporary defect information to an optical recording medium, the temporary defect information having an accumulated size equal to a multiple (N-1,2, …) of a predetermined size (K) (size that takes to fulfill TDMA1, Fig. 8), and

separately recording subsequent temporary defect information (TDMA2) on the optical recording medium, the subsequent temporary defect information having the accumulated size less than the predetermined size (K) and excluding the temporary defect information having the accumulated size equal to KxN. (see Fig. 8; Fig. 13).

Regarding claim 2, Park et al. discloses recording size information of the temporary defect information having the accumulated size equal to KxN, information indicating a location of the temporary defect information (SDL header) having the accumulated size equal to KxN, and information indicating a location of the subsequent temporary defect information excluding the temporary defect information having the size equal to KxN on the optical recording medium (Figs. 12, 13).

Regarding claim 3, Park et al. discloses wherein the optical recording medium is a write once medium. (see col. 2 lines 13-29).

Regarding claims 4 and 5, recites similar limitations to the above treated in claims 1 and 2 and met by Park et al. reference for the same reasons of anticipation.

Regarding claim 6, Ito et al. discloses if a size of the subsequent temporary defect information reaches the predetermined size K, contiguously recording the temporary defect information having the size equal to KxN and the rsubsequent temporary defect information excluding the temporary defect information having the accumulated size equal to KxN, to at least one portion of the optical recording medium (see Figs. 86 and 8; contiguously performed to TDMA3, TDMA4 etc.)

Regarding claim 7, discloses recording size information (KxN+K) of the "contiguously" recorded temporary defect information and information indicating a location of the continuously recorded temporary defect information to the optical recording medium (See Fig. 12; contiguously for TDMA 3, TDma4 etc.).

Regarding claims 8-14, Apparatus claims 8-14 are drawn to the apparatus corresponding to the method of using same as claimed in claims 1-7, and are rejected for the same reasons of anticipation as used above.

Regarding claims 15-21, recording medium claims 15-21 are drawn to the recording medium recorded using the corresponding method and apparatus as claimed in claims 1-7; and 8-14, and are rejected for the same reasons of anticipation as used above.

Regarding claim 22, claim 22 is drawn to the program being used for performing the method performed by the apparatus of claim 12, and further reciting the limitations of using the temporary defect information recorded, which are met by Ito et al reference. Hence, is rejected for the same reasons of anticipation as used above.

Response to Arguments

Applicant's arguments filed 02/13/2009 have been fully considered but they are not persuasive.

With respect to rejections of the first paragraph of 35 U.S.C. 112:

Applicant argues that the claims are fully supported by the disclosure and that the subject matter for "contiguously" is described in paragraphs [0037], [0083], [0084] and [0088].

However, such description appears nowhere to be found. None of the paragraphs above specified and/or the drawings shows or specify "contiguously". It appears that the Applicant wants to attribute to "continuously" to be "contiguous" as well. Whether the word "continuously" may comprise a sequence, doe snot implies that such sequence implies that are adjacent as provided by the non supported word "contiguously". The specification is very clear, as originally field it is described with respect to the drawings to be "continuously".

However, these two different words with related but two **different meanings** which the later provides for **a scope not supported** by the specification as originally filed. This limitation is New Matter added to the disclosure and the claims.

For purposes of art rejections and examination this limitation is consider as "continuously".

With respect to rejections under 35 U.S.C. 102 (e):

Applicant argues that the reference of Park et al. 7,289,404 is disqualified as an applicable prior art.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. The Verified English Language translations of the foreign priority papers have not in fact been received.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JORGE L. ORTIZ CRIADO whose telephone number is (571)272-7624. The examiner can normally be reached on Mon.-Fri 10:00 am- 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jorge L Ortiz-Criado/
Primary Examiner, Art Unit 2627